

REMARKS

The Office Action mailed October 6, 2006, has been received and reviewed. Claims 1 through 27 are currently pending in the application, of which claims 1 through 9 are currently under examination. Claims 10 through 27 are withdrawn from consideration as being drawn to a non-elected invention. Claims 1 through 9 stand rejected. Applicants have amended claim 1. Support for the amendment may be found throughout the as-filed specification, such as at paragraphs [0021], [0030], and [0042]. Applicants respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent 6,378,976 to Byers *et al.*

Claims 1 through 6, 8, and 9 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Byers *et al.* (U.S. Patent 6,378,976) (hereinafter “Byers”). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding independent claim 1, Applicants assert that Byers does not describe, either expressly or inherently, each and every element of claim 1 as recited in the claims to anticipate the claimed invention under 35 U.S.C. § 102. Byers does not describe the element of the claimed invention reciting “applying a fixer to the portion of the medium in the pattern; and applying an ink to a different portion of the medium” as recited in amended claim 1. Byers discloses printing an ink over a fixer or *vice versa*. *Column 4, lines 28-36*. Byers discloses printing a test page with only a fixer. *Column 6, lines 1-10*. Byers discloses printing a test page with only an ink. *Column 6, lines 34-37*. Byers does not describe applying a fixer to a portion of the medium and applying an ink to a different portion of the medium. Therefore, for at least this reason, Byers does not anticipate claim 1.

Claims 2 through 6, 8, and 9 are novel for at least the reason of depending from novel independent claim 1.

35 U.S.C. § 103(a) Rejections

Obviousness Rejection Based on Byers in view of U.S. Patent 6,134,025 to Takeuchi *et al.*

Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Byers in view of Takeuchi *et al.* (U.S. Patent 6,134,025) (hereinafter "Takeuchi").

Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding claim 7, Applicants assert that Byers and Takeuchi, assuming combinability for the sake of argument, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103, for all of the reasons discussed above with regard to the Section 102 rejections. Therefore, claim 1 is non-obvious. Claim 7 is non-obvious for at least the reason of depending from claim 1.

ENTRY OF AMENDMENTS

The proposed amendments to claim 1 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. The Examiner's first search should have covered the invention as described and claimed, including the inventive concepts towards which the claims appear to be directed. *M.P.E.P. § 904*. Therefore, the subject matter of amended claim 1 should have been previously searched by the Examiner. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1 through 27 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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